

### REMARKS

Claims 1, 3, 5, 6, 9-18 and 20 have been amended to correct formatting errors and to improve readability. No new matter has been added.

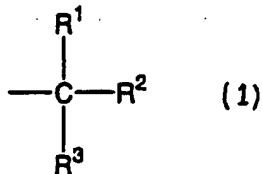
Claims 1-3, 15, 16 and 18-20 stand rejected under 35 USC 102(b) as being anticipated by Sasahara. This rejection is respectfully traversed.

The translation of Sasahara provided with the office action is an incorrect computer translation. For the Examiner's convenience, an English translation of the abstract and claims of Sasahara are provided with this amendment.

All of the pending claims depend from claim 1, which claims a positive-working radiation-sensitive composition including a positive-working radiation-sensitive composition containing a) a compound with an alkali-soluble group protected by an acid labile group *a* and b) an acid generator which generates acid by irradiation with radiation, and one of conditions a1) to a3) are satisfied. The Examiner states that Sasahara discloses a positive-working composition as claimed in which condition a1) is satisfied. As described below, Sasahara does not satisfy condition a1).

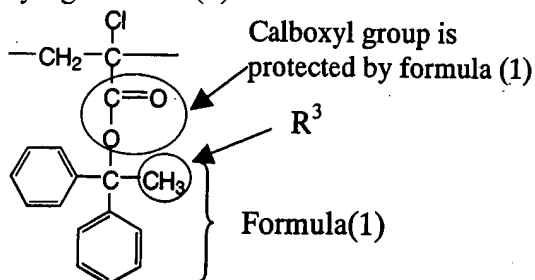
Condition a1) states:

The alkali-soluble group is a carboxyl group and the acid labile group is represented by general formula (1):



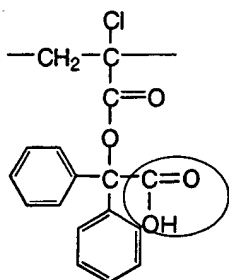
(R<sup>1</sup> and R<sup>2</sup> are aromatic rings, and R<sup>3</sup> represents an alkyl group, a substituted alkyl group, a cycloalkyl group or an aromatic ring; and R<sup>1</sup> to R<sup>3</sup> may be the same or different)

An example of a compound satisfying formula (1) is:

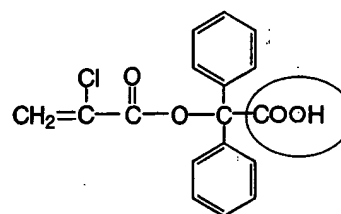


Sasahara describes compounds having the following formulas:

B-22 in JP-A-07-295221



M-22 in JP-A-07-295221



Presumably, the Examiner believes that the circled portions correspond to  $R^3$  in formula 1. As claimed by Applicants',  $R^3$  is an alkyl group, a substituted alkyl group, a cycloalkyl group or an aromatic ring. The circled portions are carboxyl groups, which are not included as a possible  $R^3$  group. Further, B-24 and M-24 also disclose a carboxyl group side chain attached to the polymer.

As claimed, the acid labile group of formula 1 protects a carboxyl group. If  $R^3$  in formula (1) is a carboxyl group, the acid labile group is an acid and will not be able to protect the carboxyl group.

Since Sasahara does not disclose a compound that contains the claimed  $R^3$  group, claim 1 should be allowed. Claims 2, 3, 15, 16 and 18-20, which depend from claim 1, should be allowed for at least the same reason.

Applicants acknowledge that claims 4-14 and 17 would be allowed if rewritten in independent form. However, in light of the proceeding remarks, no amendment is deemed necessary.

For the foregoing reasons a notice of allowance is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 360842008500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By: 

Jonathan Bockman

Registration No.: 45,640

MORRISON & FOERSTER LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7769 – Telephone No.

(703) 760-7777 – Facsimile No.